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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,934	06/03/2002	Gour Mukherji	RLL-165US	3005

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EXAMINER

YOUNG, MICAH PAUL

ART UNIT PAPER NUMBER

1618

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,934

Applicant(s)

MUKHERJI ET AL.

Examiner

Micah-Paul Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 6-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgment of Papers Received: Amendment/Response dated 2/23/06.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1,3,4,6-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the disclosures of Dunn et al (USPN 5,681,581 hereafter '581). The claims are drawn to composition comprising a film coating where the coating comprises film-forming materials in combination with high viscosity swellable polymers.

4. The '581 patent discloses coated particles where the coating comprises multiple polymers including methacrylic acid copolymers, hydrogel polymers such as Carbopol, and cellulosic polymers (col. 6, lin. 47-col. 7, lin. 50). The formulation further comprises plasticizers such as diethyl phthalate and polyethylene glycol (col. 8, lin. 14-33); diluents such as lactose (col. 7, lin. 57-67) and lubricants such as magnesium stearate (col. 8, lin. 1-12). The coated particles are formed into tablets for oral delivery (examples). The reference however discloses different concentrations of the highly viscous polymer, and other excipients. These components are common within the art and would be well within the level of skill of an ordinary artisan to optimize.

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5. Regarding the highly viscous polymer, it is the position of the Examiner that barring a showing of unexpected results for the claimed concentration the limitation does not impart patentability on the claims. The '581 patent discloses a formulation comprises a combination of polymers wherein the combination includes highly viscous polymers such as Carbopol (col. 7, lin. 35-50). The reference further discloses the combination of plasticizers, diluents, and lubricants. It is the position of the Examiner that the general conditions of the claims have been met. Applicant is reminded that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *See In re Aller*, 220 F.2d 454 105 USPQ 233, 235 (CCPA 1955).

6. Furthermore the claims differ from the reference by reciting various concentrations of the active ingredient(s). However, the preparation of various pharmaceutical compositions having various amounts of the active is within the level of skill of one having ordinary skill in the art at the time of the invention. It has also been held that the mere selection of proportions and ranges is not patentable absent a showing of criticality. *See In re Russell*, 439 F.2d 1228 169 USPQ 426. (CCPA 1971).

7. With these things in mind it would have been obvious to one of ordinary skill to follow the teachings of the '581 reference in order to provide an optimized coated particle with improve release. It would have been obvious to one of ordinary skill in the art to follow these teachings with an expected result of a controlled release formulation capable of intestinal release of an active agent.

Response to Arguments

8. Applicant's arguments filed 2/26/06 have been fully considered but they are not persuasive. Applicant argues that:

- a. The Dunn reference does not disclose a combination of film-forming polymers and highly viscous polymers.

Regarding this argument the Examiner disagrees with applicant assessment of the prior art. Dunn discloses a coating composition comprising multiple polymer coating materials (examples 1-6). Among these combined polymers are Carbopol (col. 7, lin. 35-50) and Methocel and methylcellulose polymer. These polymers are recited by applicant as being useful in the coating composition of the invention. Applicant is invited to provide any evidence that differentiates the claimed composition from the disclosed composition. The Office does not have the facilities for examining and comparing applicant's product with the product of the prior art in order to establish that the product of the prior art does not possess the same material structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed products are functionally different than those taught by the prior art and to establish patentable differences. *See Ex parte Phillips*, 28 U.S.P.Q.2d 1302, 1303 (PTO Bd. Pat. App. & Int. 1993), *Ex parte Gray*, 10 USPQ2d 1922, 1923 (PTO Bd. Pat. App. & Int.) and *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977).

9. Until such evidence can be provided the claims remain obviated by the art.

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Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mehta (USPN 4,800,087) teaches a formulation comprising a coating comprising at least two polymers including methylcellulose and acrylic copolymers such as Eudragit polymers.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Micah-Paul Young whose telephone number is 571-272-0608. The examiner can normally be reached on M-F 7:00-4:30 every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Micah-Paul Young
Examiner
Art Unit 1618


MP Young


MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER